Gray Cary Ware A Freidenrich LLP

FAX TRANSMISSION COVER SHEET

To:

Examiner Ahmad Matar

Art unit 2700

Telephone:

(703) 305-4731

Client-Matter Number:

103739.991101

Austin, TX 7870'î

Tel: 512-457-7000 Fax: 512-457-7070 www.graycary.com June 1, 1999 **2**001

JUN 03 1999

From:

Steven R. Sprinkle

512-457-7025 457-7025

Re:

Petition to Make Special

Pages: - 20 - (including this form)

If there is a problem with this transmission, please call (512) 457-7000 Fax Operator/Ext.

Message:

Examiner Ahmad Matar:

Please find attached to this facsimile transmission a Petition to Make Special Because of Actual Infringement Pursuant to 37 C.F.R. § 1.102. I would very much appreciate your attention to this matter at your earliest convenience. Please let me know if I can provide you, with additional information. Thank you for your time and consideration.

Steve Sprinkle

CONFIDENTIALITY NOTICE

This communication is ONLY for the person named above. Unless otherwise indicated, it contains information that is confidential, privileged or exempt from disclosure under applicable law. If you are not the person named above, or responsible for delivering it to that person, be aware that disclosure, copying, distribution or use of this communication is strictly PROHIBITED. If you have received it in error, or are uncertain as to its proper handling, please immediately notify us by collect telephone and mail the original to us at the above address. Thank you.

OFPUA

09/060.867 Attorney Docket No.: ACUI-1100-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE FAX RECEIVED

Applicant:

Andrew T. Busey, et al.

JUN 03 1999

Serial No .:

09/060,867

Group 2700

Filing Date:

April 15, 1998

Group Art Unit:

2700

Examiner:

Ahmad Matar

Title:

METHOD AND APPARATUS FOR REAL TIME

NETWORK COMMUNICATION

VIA FACSIMILE

Assistant Commissioner of Patents Washington, D.C. 20231

CERTIFICATION UNDER 37 CFR § 1.6(d)

I hereby certify that the documents referred to as attached herein are being transmitted to the The Assistant Commissioner of Patents via facsimile, on this date, June 1, 1999, directed to the facsimile number (703) 308-5357, addressed to Examiner Ahmad Matar in Group Art Unit 2700.

Janice DiPetto

PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT **PURSUANT TO 37 C.F.R. § 1.102**

Sir:

Applicants submit this Petition to the Commissioner under 37 C.F.R. § 1.102 to make special and advance the examination of the above-identified application because of actual infringement.

This petition is accompanied by: (1) an Information Disclosure Statement; and (2) a Declaration by Edward C. Horvath in Support of Petition to Make Special Because of Actual Infringement.

Applicants hereby file this petition to make special and request that this petition be granted and that the application be allowed.

Authorization is hereby given to deduct the fee for filing this petition to make special because of actual infringement of \$130.00 from Deposit Account No. 50-0456, as set forth in 37 C.F.R. § 1.17(i). While no other fees are believed due, authorization is also given to charge any additional fees in connection with this petition to Deposit Account No. 50-0456.

Attorney Docket No. ACUI-1100-1 Page 2 09/060,867

In the event matters remain to be resolved in view of this communication, the Examiner is invited to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

GRAY CARY WARE A FREIDENRICH LLP

Steven R. Sprinkle

Registration No. 40,825

Date: June 1, 1999

100 Congress Avenue, Suite 1440

Austin, Texas 78701

Telephone: (512) 457-7025 Facsimile: (512) 457-7070

09/060,867

Attorney Docket No.: ACUI 1100-1

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Group 2700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Andrew T. Busey, et al.

Serial No.:

09/060,867

Filing Date:

April 15, 1998

Title:

METHOD AND APPARATUS FOR REAL TIME

NETWORK COMMUNICATION

Assistant Commissioner of Patents Washington, D.C. 20231

CERTIFICATION UNDER 37 CFR §1.10

I hereby certify that the documents listed below are being deposited with the United States Postal Services as "Express Mail" in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

Rebecca J. Morrison

DECLARATION BY EDWARD C. HORVATH IN SUPPORT OF PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT

I, Edward C. "Ned" Horvath, Chief Technical Officer for Acuity Corporation (assignee of the above-referenced application) do hereby make the following declarations:

- 1. The present application is a continuation application filed April 15, 1999 as a continuation of parent application serial number 08/722,898, now issued as U.S. Patent Number 5,764,916 (the "916 Patent").
- 2. On or about January 1997, named inventor Andrew Busey, at the time an employee of the assignee ichat, inc. ("ichat"), initially became aware that eShare Technologies ("eShare") had developed a chat-based product accessible through the eShare web site that might infringe the claims of this and other applications filed by ichat.

AUW014345.1 103739-991101 ATTORNEY DOCKET NO.: ACUI-1100-1

09/060,867

-2-

- 3. On or about May 1998, in my role as ichat's Chief Technology Officer, I became aware that Yahoo, America OnLine ("AOL") and Excite had each deployed a chat-based product accessible through these company's respective web sites that might infringe the claims of this patent application.
- 4. On or about August 1998, assignee ichat changed its corporate name to Acuity Corporation ("Acuity").
- 5. On or about May 1, 1999, I completed a rigid comparison of the eShare, AOL, Yahoo and Excite products with the claims of the present application. Based on this comparison, it is my opinion that at least Claims 1-3 of this patent application are unquestionably infringed by the eShare, AOL, Yahoo and Excite products.
- 6. The eShare product was accessed by going to an eShare customer at the web site www.lockon.com (see attached Exhibit A).
- 7. The Yahoo product can be accessed at web site www.yahoo.com (see attached Exhibits B-G).
- 8. The AOL product can be accessed at web site www.aol.com (see attached Exhibits H and I).
- The Excite product can be accessed at web site www.excite.com (see attached Exhibits J and K).
- 10. I have a good knowledge of the pertinent prior art. The prior art made of record in the parent '916 patent, and therefore of record in this continuation application, along with the art contained in the accompanying Supplemental Information Disclosure Statement represent the pertinent prior art.
- I believe that all of the claims in this application are allowable over the prior art.
- 12. All statements made herein of my own knowledge and are true and all statements made on information and belief are believed to be true; these statements were made

ATTORNEY DOCKET NO.: ACUI-1100-1

09/060,867

- 3 -

with the knowledge that willful false statements and the like so made are punishable by fine, imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

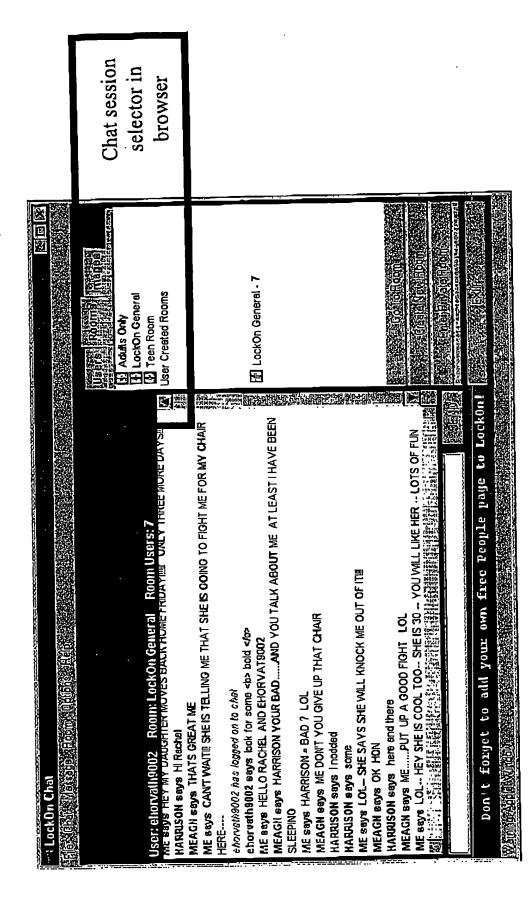
Respectfully submitted,

Edward C. Horvath

Chief Technical Officer, Acuity Corporation

Date: May 3, 1999

eShare (lockon.com) chat in browser



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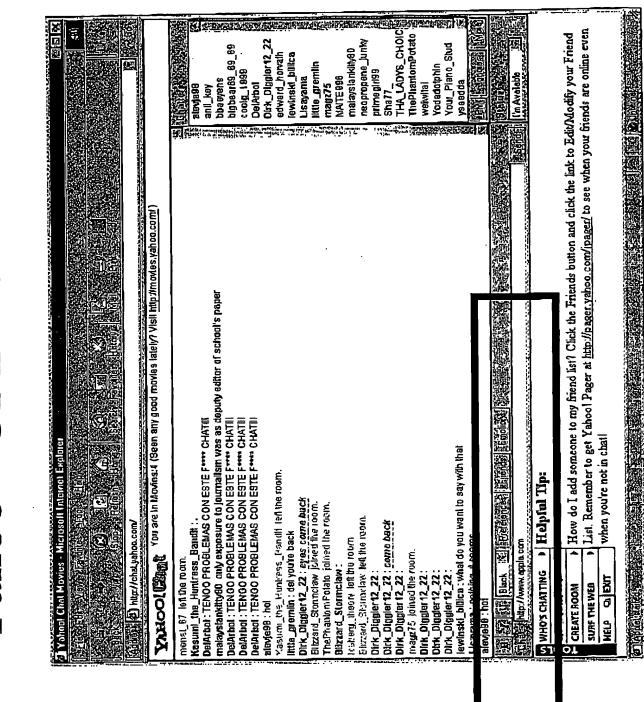


Exhibit F

Yahoo - URL - after

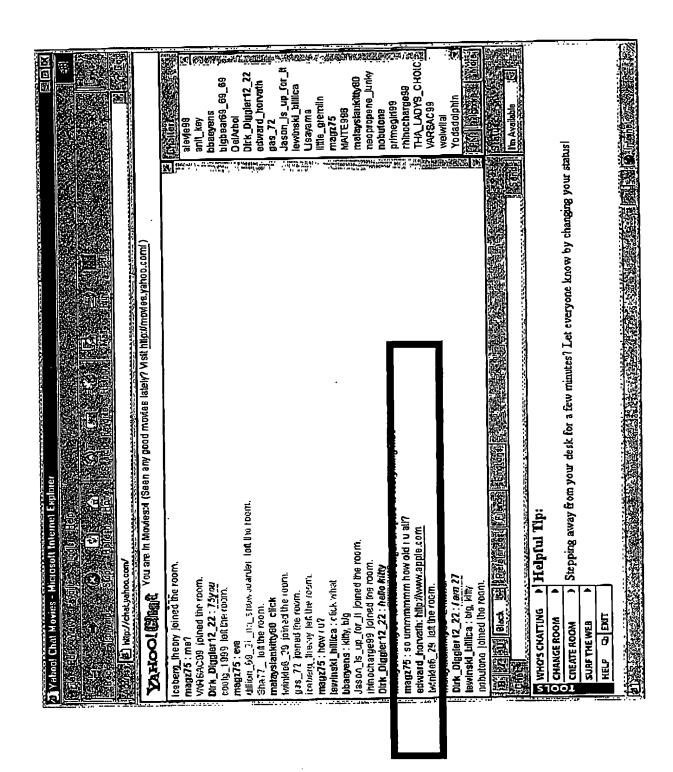


Exhibit G

Yahoo - browser doc selects chat

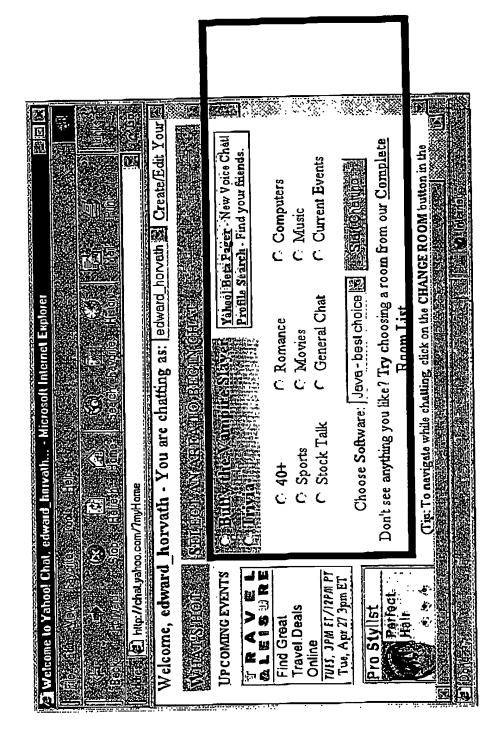


Exhibit H

AOL Chat

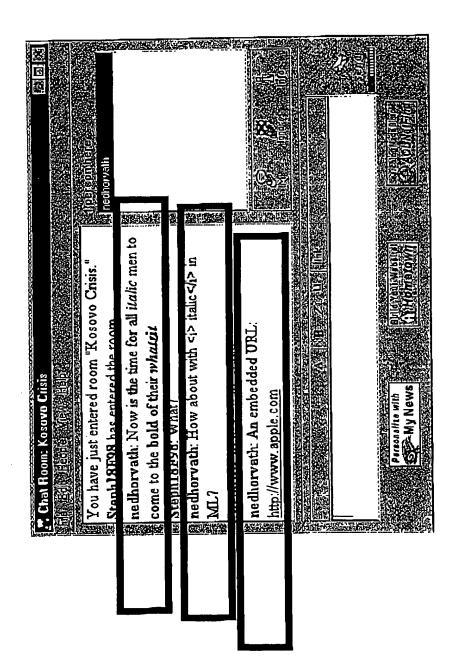
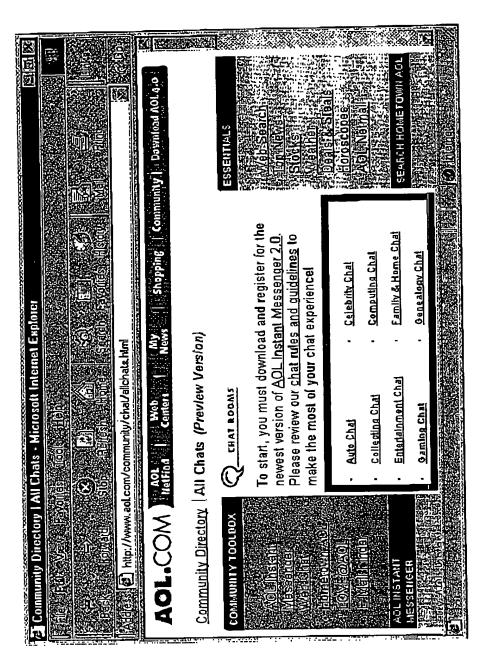


Exhibit I

AOL - browser doc selects chat



Excite - browser doc selects chat

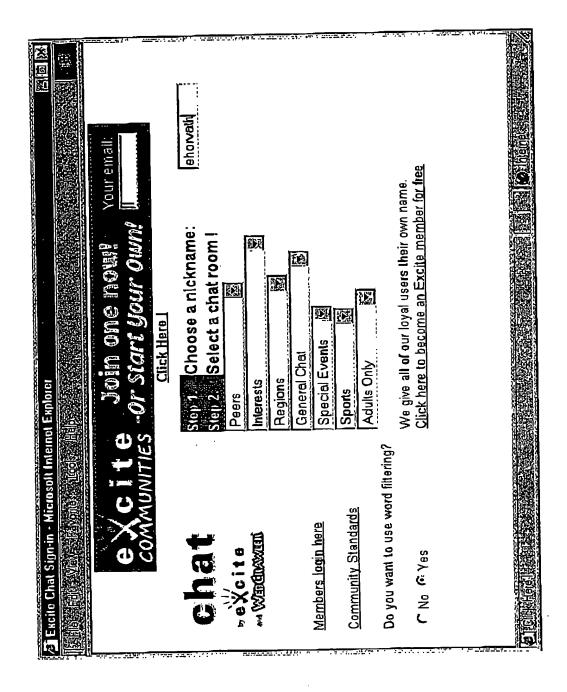
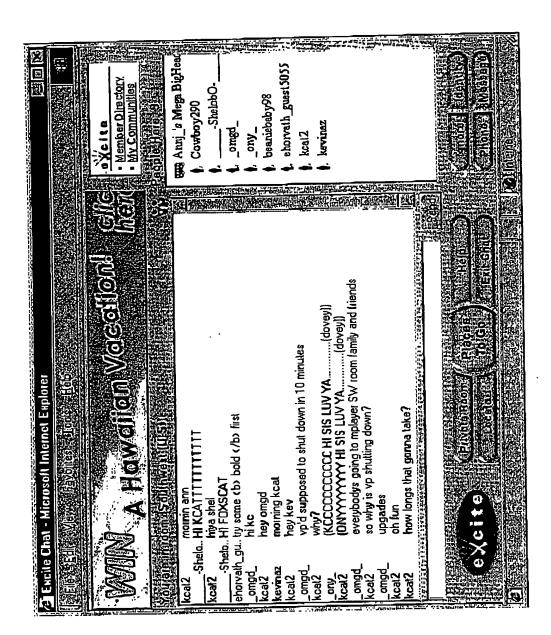


Exhibit K

Excite chat in browser



09/060,867

Attorney Docket No.: ACUI-1100-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Andrew T. Busey, et al.

Serial No.:

09/060,867

Filing Date:

April 15, 1998

Group Art Unit:

unknown

Examiner

unknown

Title:

METHOD AND APPARATUS FOR REAL TIME

NETWORK COMMUNICATION

CERTIFICATION UNDER 37 CFR § 1.0

Assistant Commissioner of Patents
Washington, D.C. 20231

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as "Express Mail" on this date, May 3, 1999, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231

Rebecca J. Morrison

Date

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. §§ 1.56, 1.97 and 1.98, applicant respectfully requests that the references listed on the attached PTO-1449 form be considered and cited in the examination of the above-identified application. A copy the cited references are enclosed for the convenience of the Examiner. Furthermore, pursuant to 37 C.F.R. §§ 1.97(g) and (h), no representation is made that a search has been made or that this art is material to patentability of the present application.

There are no fees due in connection with the filing of these documents. However, should the Examiner deem any fees necessary, the undersigned hereby authorizes the deduction of said fees from Deposit Account No. 50-0456 of Gray, Cary, Ware & Freidenrich.

Attorney Docket No. ACUI-1100-1 Page 2 09/060,867

Applicant respectfully submits that the claims of Applicant's above-referenced patent application are patentably distinguishable from these references.

Respectfully submitted,

GRAY CARY WARE A FREIDENRICH LLP

William N. Hulsey III
Registration No. 33,402

Date: May 3, 1999

100 Congress Avenue, Suite 1440

Austin, Texas 78701

Telephone: (512) 457-7040 Facsimile: (512) 457-7070

FORM PTO 1449 US Department of Commerce Patent and Trademark Office	ATTY DOCKET NO.: ACUI-1100-1 APPLICANT(S): Andrew	SERIAL NO.: 09/060,867 T. Busey, et al.
INFORMATION DISCLOSURE STATEMENT BY APPLICANT	FILING DATE: April 15, 1998	GROUP ART UNIT: unknown

U.S. PATENT DOCUMENTS

EXAM.		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
INITIALS	A1	5,659,729	8-19-97	Nielscn	395	603	2-1-96
	A1 A2	5,671,428	9-23-97	Muranaga, et al.	395	772	8-28-92
	A2 A3	5,220,657	6-15-93	Bly, et al.	395	425	4-15-91
	A4	5,159,669	10-27-92	Trigg, et al.	395	159	12-15-88
	A5	5,796,393	8-18-98	MacNaughton, et al.	345	329	11-8-96
	A6	5,828,839	10-27-98	Moncreiff	395	200	11-14-96
	A7	5,862,330	1-19-99	Anupam, et al.	395	200	7-16-96
	A8						
	A9						

FOREIGN PATENT DOCUMENTS

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EXAM. INITIALS		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION (YES/NO)
	B1						
	B2						

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages)

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EXAMINER	DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

From:

"Barry Price" < bprice@acuity.com>

To:

"'kcrobertson@graycary.com'" <kcrobertson@graycary...

Date:

5/25/99 9:58am

Subject:

FW: Acuity patent status

----Original Message--

From: Barry Price

Sent Friday, May 14, 1999 12:26 PM

To: 'William Hulsey'

Cc: Ned Horvath; Michael Oswald; Rick Ross; Barry Price

Subject: RE: Acuity patent status

Bill, thanks for meeting with us yesterday. I think we made good progress on defining how to respond to the office action rejecting our patent.

I would like to talk to you briefly today about the status of our other patents. I'm trying to update the patent status spreadsheet for Michael and Mark Saul. Listed below are the specific questions I have, Please give me a call when you can.

Thanks, Barry Price 425-2237

- 1) USP 5,764,916 (granted patent): What is the status of eShare responding to our infringement notification, or our response to their request for a prosecution history. When, and what, are the next steps with eShare?
- 2) SN 09/060,867 <continuation of above>: The petition to make special was filed 5/3. When should we expect a response from the patent office? FYI I'm recommending to Mark that we wait for this continuation to be granted before aggressively pursuing infringements of the granted patent. My reasoning is that the granted patent is to easy to work around and difficult to detect infringement. With the continuation, however, we would have a very easily detectable, and strongly enforceable patent.
- 3) SN 08/741,470 <the rejected patent>: Per our discussion yesterday you will prepare a response to the rejection office action. And Ned will gather evidence of when the '916 patent was conceived. When should we expect to have the office action response ready to review and send to the patent office?
- 4) SN 08/768,606 <continuation of above>: My notes indicate that on 5/3 we filed a supplemental amendment to remove the Busey '916 patent as prior art and we expect the examiner to proceed immediately without the need to file a make special request. Is this what will reall—house the continuation of the rejected application, isn does this now work? In the rejection responsant continuation as well, or is this application s

5	ACUITY
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